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BS02302 CON 2

U.S. Application No. 10/717,892 Examiner RAMOS FELICIANO, Art Unit 2617
Petition to Revive, Notice of Appeal, and Pre-Appeal Brief Request for Review in Response to November 16, 2005
Final Office Action

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Koch, Robert A.

Group Art Unit: 2617**Application No.** 10/717,892**Examiner:** Ramos Feliciano, Eliseo**Filed:** 20 November 2003**Attorney Docket:** BS02301 CON 2**Title:** "System & Method for Providing Usage Monitoring Telephony Services"

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Assignee requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated below.

1. **Because No "Teaching, Suggestion, or Motivation" was Cited, Each § 103 (a) *Prima Facie* Case for Obviousness Is Improper**

The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner's *prima facie* case for obviousness must include "some teaching, suggestion, or motivation" to combine prior art that is found "either in the references themselves or in the knowledge generally available to one of ordinary skill." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

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Here the Examiner's *prima facie* cases fail to include any teaching, suggestion, or motivation. The § 103 (a) final rejection merely states that it would have been obvious to modify *Fuller* in view of *Jones* to monitor the duration of a call. This reasoning, however, does not satisfy the Examiner's burden. The Examiner cites no passage from *Fuller* or *Jones* to support the *prima facie* burden. The Examiner also fails to assert anything found in the knowledge generally available to one of ordinary skill. The *prima facie* case for obviousness, then, is at least improper for failing to provide any teaching, suggestion, or motivation to combine, as M.P.E.P. § 2143 requires. The Appellant thus respectfully asserts that the § 103 (a) rejection of claims 1-19 should be removed on appeal.

2. Because No Reasonable Expectation of Success was Cited, Each § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner's *prima facie* case for obviousness is defective for another reason. The Examiner's *prima facie* case for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* case wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The Appellant thus respectfully asserts that the § 103 (a) rejection of claims 1-19 should be removed on appeal.

3. *Fuller* and *Jones* Fails to Teach or Suggest All the Features of Claims 1-8, 10-14, 16, and 18-19, so the § 103 (a) Rejection Fails

Claims 1-8, 10-14, 16, and 18-19 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,775,546 to *Fuller* in view of U.S. Patent 6,195,422 to *Jones et al.* These claims, however, recite, or incorporate, features that are not taught or suggested by *Fuller* and *Jones*. Independent claim 1, for example, recites "*receiving a call directed to a virtual*

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telephone number in a service-providing network, the service-providing network providing intelligent services to said call.” The call is then “rout[ed] ... to a separate native transport network from which said call originates.” The duration of the call “traversing the service-providing network” is then monitored. Independent claim 11 recites “a communications switch in a service-providing network receiving a call directed to a virtual telephone number, the call received from a separate native-transport network having limited capability of providing the intelligent service to the call.” Claim 11 also recites “an application server communicating with the communications switch, the application server providing the intelligent service to the call, the intelligent service comprising monitoring a duration of the call traversing the service-providing network.” Claim 11 continues to recite “wherein after the intelligent service is provided to the call, the switch routes the call from the service-providing network to the call’s intended destination.”

The proposed combination of *Fuller* and *Jones* fails to describe such features. *Fuller* and *Jones*, whether independently or jointly, fail to teach or suggest a “service-providing network” and a “separate native transport network.” As the Appellant has previously argued, the Examiner’s interpretation of *Fuller* is not supported by the textual evidence. The Office, for example, continues to maintain that the calling party’s terminal, the gateway mobile switching center, the service control point, and the home location register (respectively shown in FIG. 2 of *Fuller* as reference numerals 41, 42, 43, and 44) is a “service providing network,” as recited in independent claims 1 and 11. The Office also interprets the base station controller (BSC), the base station, and the mobile handset (respectively shown in FIG. 2 of *Fuller* as reference numerals 47, 30, and 21) as a “separate native transport network,” as also recited in independent claims 1 and 11.

Fuller’s textual evidence, however, does not support the Office’s interpretation. *Fuller* clearly describes all the components shown in FIG. 2 as a cellular telephone system. That is, *Fuller* only discloses a single network. *Fuller* fails to teach or suggest a “service-providing network” and a “separate native transport network.” As *Fuller* explains, “[f]irst it is necessary to

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describe the basic layout of a typical cellular telephone system." U.S. Patent 6,775,546 to Fuller (Aug.10, 2004) at column 5, lines 9-10. "FIG. 2 illustrates the components of the network architecture supporting this system." *Id.* at column 5, lines 12-13. "Connection with other networks, and ultimately from the calling party 41, is made through a "Gateway Mobile Switching Centre" (GMSC) 42." *Id.* at column 5, lines 13-15 (emphasis added).

The proposed combination of *Fuller* and *Jones*, then, does not support the Office's interpretation. *Fuller* describes all the componentry of FIG. 2 as a single cellular network. *Fuller* and *Jones*, then, fails to teach or suggest "receiving a call directed to a virtual telephone number in a service-providing network, the service-providing network providing intelligent services to said call." The patents to *Fuller* and *Jones* also fail to teach or suggest "routing said call to a separate native transport network from which said call originates." Because *Fuller* and *Jones* is silent to at least these features, one of ordinary skill in the art, then, would not consider the pending claims obvious in view of *Fuller* and *Jones*. The proposed combination of *Fuller* and *Jones*, then, cannot obviate claims 1-8, 10-14, 16, and 18-19. The *prima facie* case for obviousness must fail, so the Office is requested to remove the rejection.

4. *Fuller, Jones, and Dent* Fail to Teach or Suggest All the Features of Claims 9, 15, and 17, so the § 103 (a) Rejection Fails

Claims 9, 15, and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Fuller* in view of *Jones* and further in view of Published U.S. Patent Application 2003/0050100 to *Dent*. The proposed combination of *Fuller, Jones, and Dent*, however, still fails to describe "receiving a call directed to a virtual telephone number in a service-providing network, the service-providing network providing intelligent services to said call." The patents to *Fuller, Jones, and Dent* also fail to teach or suggest "routing said call to a separate native transport network from which said call originates." One of ordinary skill in the art, then, would not consider the pending claims obvious, so the *prima facie* case for obviousness must fail. The Office is thus required to remove the rejection.

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If any issues remain outstanding, the Office is requested to contact the undersigned at
(919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", with a stylized flourish at the end.

Scott P. Zimmerman
Attorney for the Assignee
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